

REMARKS

Favorable reconsideration of this patent application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 2-8, 17-21, and 26-31 have been rejected as being non-enabling under 35 USC 112; Claims 20, 26, 27, 29, and 30 have been rejected as being unpatentable over Winn in view of Poulsen under 35 USC 103; Claims 8, 18, and 21 have been rejected as being unpatentable over Winn in view of Poulsen and Baker et al. under 35 USC 103; Claims 2-5, 7, and 17 have been rejected as being unpatentable over Winn in view of Poulsen and Teegarden et al. under 35 USC 103; Claim 19 has been rejected as being unpatentable over Winn in view of Poulsen, Baker et al., and Ferguson under 35 USC 103; Claim 6 has been rejected as being unpatentable over Winn in view of Poulsen, Teegarden et al., Price, and Ferguson under 35 USC 103; and Claims 28 and 31 have been objected to as containing

allowable subject matter but being dependent from rejected parent claims. Claims 26 and 29 have been cancelled, new Claims 32 and 33 have now been inserted, and consequently, Claims 2-8, 17-21, and 27, 28, and 30-33 are now active in this patent application.

The interview conducted with Examiner Chan is hereby acknowledged and sincerely appreciated as a means for expediting the prosecution of this patent application toward allowance. During the course of the interview, newly inserted Claims 32 and 33 were fully discussed in light of the prior art of record, and it was agreed that such claims patentably defined over the prior art of record, particularly Winn and Poulsen, in that none of such prior art, or any other prior art of record, discloses the use of the sensor in conjunction with the contact member, for determining the distance of the contact member from the sensor, and therefore, in effect, the height of the particular cigarette carton as more fully disclosed, for example, at Page 12 of the specification. It is therefore submitted that all of the claims of this patent application patentably define over all of the prior art of rec-

ord.

In connection with the rejection of the claims as being non-enabling under 35 USC 112, it is respectfully submitted that the claims are in fact proper and enabling under 35 USC 112, and therefore, the rejection of the claims under 35 USC 112 should be withdrawn.

More particularly, the specification clearly discloses the presence of contact member 48 and the sensor 42, and the claims recite a contact member and a sensor means. In accordance with 35 USC 112, applicant is permitted to recite the sensor 42 as a sensor means for sensing the disposition of the contact member. It is therefore respectfully submitted that such a claim recitation is in fact a proper recitation of operative structure in the "means for" language format.

The examiner cited Section 2164.08(c) of the MPEP as support for his position in rejecting the claims under 35 USC 112 as being non-enabling, in that applicant's specification states that the provision of the ultrasonic sensor is a critical element of the apparatus system of the present invention and that such element must therefore be claimed. Applicant strenuously rejects this position.

What is stated as a critical element to the present invention is the provision of a sensor, NOT the TYPE of sensor, for use in conjunction with the contact plate for determining the distance of the contact plate from the sensor, and therefore, in turn, for determining the height of the particular cigarette carton. Without the presence of A sensor, NOT the particular TYPE of sensor, the system would be inoperative and non-enabling, and that is precisely the gist, meaning, intention, import, or significance of 35 USC 112 and the noted section of the MPEP.

It is additionally noted that Section 2164.08(c) also states that "Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality." It is respectfully noted to the examiner that not only is the ULTRASONIC sensor omitted from the abstract, it is likewise omitted from the FIELD OF THE INVENTION and THE SUMMARY OF THE INVENTION sections of the specification. Still yet further, and probably most importantly, the ULTRASONIC sensor, that is, the TYPE of sensor was never even originally claimed and has only now been claimed as a result of claims, directed toward such an ultra-sonic sensor, having been newly inserted into the amendment which accompanied the Request For Continued Examination (RCE) filed on May 23, 2005.

Therefore, again, it is respectfully submitted that the claims are in fact proper and enabling under 35 USC 112, that the criticality of the TYPE of sensor has in fact been clearly rebutted, and that the rejection of the claims under 35 USC 112 should be withdrawn.

In light of the foregoing, it is submitted that this patent application is now in condition for allowance, and an early and favorable action is now anticipated and awaited.

Respectfully Submitted,
SCHWARTZ & WEINRIEB



Steven W. Weinrieb
Attorney of Record
Registration No. 26,520
(703) 415-1250